IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Gregory P. Andrews et al.   Art Unit: 2142
Application No.: 08/818,158   Examiner: Thong H. Vu
Filed: March 14, 1997
For: A COMPONENT DOWNLOAD SELECTION MECHANISM FOR WEB BROWSERS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Sir:

This paper is submitted in reply to the final Office Action dated November 3, 2006, and is submitted in connection with a Notice of Appeal. Applicants respectfully request pre-appeal brief review of the final rejections in the above-identified patent application for two clear errors, set forth in greater detail below. The first clear error is that the Examiner is improperly taking a position that the Examiner should be estopped from taking, based upon a prior appellate Decision issued in this case. The second clear error is that the Examiner is engaging in piecemeal examination, and is reissuing essentially the same rejections over and over again, but applying new references that teach little beyond the other references applied against the claims.

In particular, with respect to the first clear error, Applicants respectfully request review of the final rejections based upon the fact that the Examiner should be estopped from taking the position the Examiner has chosen to take in the art-based rejections of the claims, as the Examiner's position is entirely inconsistent with the prior decision of the Board of Patent Appeals and Interferences issued in this application.

All of Applicants claims are directed at least in part to the concept of prompting a user to select which components, among a plurality of components referenced by a file being downloaded, should be downloaded. Applicants have consistently maintained throughout prosecution, and the Board has likewise agreed, that such components referenced by a file being

downloaded do not correspond to hypertext links to other files that may be present in a particular file being downloaded.

Applicants define "components" in the specification as "any item referenced in [an] HTML page to be <u>downloaded and integrated with the page</u>, such as graphics images, background images, audio, video and multimedia files, forms, applets, etc." (Application, page 7, lines 12-15, *emphasis added*). Based upon this definition, a hypertext link defined in a hypertext document, which references a different hypertext document that will be retrieved and displayed upon selection of the hypertext link, is not a "component' in the context of Applicants' invention.

This particular interpretation of the term "component" was accepted by the Board of Patent Appeals and Interferences in the Decision dated June 22, 2004. Specifically, the Board favorably cites page 2 of the Specification, which states:

> "Many web pages use extensive graphics and other "components" to dress up their web page, where components are defined in this patent to be any additional items referenced in HTML documents. These components are included in an HTML document through the use of specialized tags. For example . . . " (Decision, page 5, *quoting* Application, page 2).

Moreover, the Board indicates that the board considers "components" to be "items referenced in [an] HTML document." <u>Id.</u>

It is also important to note that the Board specifically found the claims to be patentable over U.S. Patent No. 6,044,382 to Martino, which essentially discloses a form-based transaction system where certain forms contain menus that link to other forms (*see,* col. 18, lines 2-22). Upon selection of a menu item on one form, Martino displays another form associated with the menu item. In many ways, the Martino system is analogous to simple conventional hypertext linking, and the Board concluded that this configuration did not disclose or suggest the concept of dynamically prompting a user to select which components, among a plurality of components referenced by a file being downloaded, should be downloaded.

Given the Board's Decision, the term "component," as used in Applicants' claims, includes items that are referenced in an HTML page, and are capable of being downloaded and integrated with the page. The term, however, <u>cannot</u> be interpreted to include links to separate HTML pages that are referenced by an HTML page.

Within this context, Applicants now turn to the instant rejections, which are all based at least in part on U.S. Patent No. 5,675,507 to Bobo II. Bobo II, however, discloses nothing more than conventional hypertext linking - a configuration over which the Board has already found the present claims to be patentable.

The Examiner cites passages in cols. 7-10 of Bobo II for allegedly disclosing prompting a user to select which of a plurality of components to download, but these columns disclose nothing more than conventional HTML hypertext linking. Specifically, the reference describes the display of a web page including a textual listing of facsimile messages, with links or anchors provided to different messages that are displayed in response to user selection of such links.

Bobo II also discloses in these columns the ability to display either reduced sized images or full size images of facsimile documents as embedded components of a message list as a form of a preview to enable a user to determine whether they would like to download the full documents (see col. 9, lines 1-37, describing the second to fifth options). It is evident from Bobo II, however, that these images themselves function as hypertext links to other documents, and no prompting is made as to whether or not to download these embedded images themselves.

Put another way, Bobo II discloses at the most the display of a list of messages with one or more preview images of a portion of each message embedded in the list, such that a user can select a preview image to download the complete message. The preview images, however, are always downloaded with the message list, and the user is never "prompted" in connection with the download of the message list, whether the user would like to download these preview images. Furthermore, the messages that are linked to by the preview images in the message list are separate documents and are not embedded into the message list itself. This conclusion is supported by col. 9, lines 11-14, 27-29, and 33-37, which disclose the downloading of a message in response to selection of a preview image.

Therefore, it is apparent from a reading of Bobo II that, with regard to the concept of embedded components, the reference discloses nothing more than conventional graphical HTML hypertext links, whereby embedded images may be associated with links to other HTML files such that a user may click on a displayed image to download a different file. However, it is important to note that these embedded images are themselves automatically downloaded along with the HTML page within which they are embedded, and a user is never prompted as to

whether or not those embedded images are to be downloaded in connection with the HTML page. The only arguable "prompting" of a user occurs through the display of these embedded images, which results in the retrieval of different HTML files, rather than of those embedded images (which have already been downloaded at that point).

It should therefore be apparent that the only manner in which the Examiner could argue that Bobo II disclosed or suggested Applicants claims would require that the term "component" be read broadly enough to cover hypertext links to separate HTML files. As discussed above, however, such an interpretation is inconsistent both with the file history and the decision of the Board, and is thus a clear error on the part of the Examiner. Were the term "component" interpreted in a manner that is consistent with the Board's Decision, Bobo II could not be relied upon to disclose this feature of Applicants' invention. The Examiner should therefore be estopped from relying on a definition of the term "component" that encompasses the separate HTML files disclosed by Bobo II, and all of the Examiner's rejections should be withdrawn.

As to the second clear error, Applicants note that the current rejections are by Applicants' count the **sixth** separate rejection of the pending claims as they stand in their present form. Moreover, this rejection is the second rejection issued subsequent to a complete reversal of the Examiner's prior rejections in a decision of the Board of Patent Appeals and Interferences. It is Applicants understanding that MPEP §707(g) cautions against the use of piecemeal examination, and furthermore, MPEP §1214.04 notes that after a reversal "[t]he examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references." Applicants are of the belief that the course of prosecution of this Application is in direct contravention to both of these guidelines.

The only differences between the instant rejections and those issued in the prior Office Action are based on the addition of the Daniels reference (U.S. Patent No. 5,758,126) to the rejections of claims 38-47, 50-57, 60-62 and 65-70. Daniels, of note, was made of record in this case **prior** to the appellate Decision in this case, and the Examiner has only now, at this late point in the prosecution, chosen to combine this old reference with Bobo II.

Daniels, however, is not even cited to address the fundamental shortcoming of Bobo II with respect to the claimed "components." Daniels is only cited for allegedly disclosing dynamic prompting at col. 13, lines 9-50. Beyond the fact that this passage does not even address

dynamic prompting of a user (since the passage only discloses a system that automatically generates "turn-around" documents), Daniels does not appear to disclose any prompting of a user for the purpose of selecting which of a plurality of components in a file to download.

The new citation of Daniels, in fact, appears to serve no other purpose than freeing the Examiner from the burden of having to address Applicants' arguments with respect to Bobo II. All of the rejections issued in the Final Office Action appear to rely on the same mistaken construction of "component," and the Examiner's Response to Applicants' Arguments (¶2 of the Final Office Action) does not even attempt to address the "component" issue, but focuses instead on the "dynamic prompting" issue. Put simply, the Examiner has basically ignored Applicants' arguments regarding the definition of the term "component." If Applicants cannot even get the Examiner to attempt to rebut Applicants' arguments on this issue, Applicants have no way of moving this case towards a resolution. As such, Applicants submit the piecemeal nature of the Examination is by itself a separate clear error that should be addressed by the appeals conference.

As a result, Applicants respectfully submit that this application is ripe for pre-appeal brief review by the appeals conference. Moreover, Applicants respectfully submit that the Examiner has not met the burden necessary to sustain the present rejections, and that the rejections of the claims should be withdrawn, and the case passed to allowance.

If there are any questions regarding this paper, or which might otherwise further this case onto allowance, please contact the undersigned at (513) 241-2324. Moreover, if any other charges or credits are necessary to complete this communication, please apply them to Deposit Account 23-3000.

Respectfully submitted,

 February 2, 2007
Date

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